REMARKS

Claims 77–96 are pending in the present application.

Claims 77, 83, 93 and 96 were amended.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 77, 81–90 and 92–96 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,841,347 to *Hsu*. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent claims 77, 93 and 96 each expressly recite that the source/drain portions within the substrate and the source/drain portions on the substrate adjacent the gate electrode together function as a source or drain for the respective device. Such a feature is not depicted or described by the cited reference. *Hsu* teaches a heavily doped epitaxial layer 50 formed over shallow source drain regions 24 and 26 for lowering the sheet resistance of a silicide contact. *Hsu* is silent as to the heavily doped expitaxial regions 50 functioning, together with shallow source drain regions 24 and

26, as source or drain regions for the respective transistor. *Hsu* does not refer to the heavily doped epitaxial regions as source or drain regions or portions thereof. *Hsu* describes the doping of the epitaxial regions as preferably being merely sufficient to reach upwardly diffusing dopants from shallow source and drain regions 24 and 26, which indicates that the heavily doped epitaxial regions 50 are merely conductive contacts to the shallow source and drain regions 24 and 26.

Therefore, the rejection of claims 77, 81–90 and 92–96 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 78–80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hsu* in view of U.S. Patent No. 5,346,587 to *Doan et al.* This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted above, independent claim 77, from which the rejected claims depend, recites a limitation not depicted or described by *Hsu*. Such limitation is also not depicted or described by *Doan et al.*

Therefore, the rejection of claims 78–80 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***dvenglarik@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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